

REMARKS

Claims 1-14 and 16-51 are currently pending in the application. In the Office Action dated April 15, 2008, claims 1-14 and 16-51 were rejected. By this Amendment, no claims have been amended. No new matter has been added.

Telephone conversation

Applicants thank the Examiner for the telephone conversation on July 14, 2008. Applicants explained to the Examiner the support and statements of fact and how they corresponded to the claimed limitations. The Examiner agreed to withdraw the rejection regarding lack of mapping.

Response to Office Action

The Office Action maintained the ineffectiveness of the June 26, 2007 1.131 declaration for failure to show actual reduction to practice because of two reasons: (1) the apparatus did not work for its intended purpose; and (2) the mapping did not show the support for each individual claim. Applicants respectfully disagree because (1) the Applicants have met the burden by the filing of the 1.131 declaration and supporting evidence that the claimed invention worked for its intended purpose by at least paragraph 45 of the declaration and Exhibit F showing the successful test results, and (2) mappings for the support to all the claimed limitations are clearly stated in the 1.131 declaration.

“For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose; but it need not be in a commercially satisfactory stage of development. >See, e.g., *Scott v. Finney*, 34 F.3d 1058, 1062, 32 USPQ2d 1115, 1118-19 (Fed. Cir. 1994).< (see, MPEP 2138.05).” In other words, the invention need not be perfect or incapable of further improvement to constitute actual reduction to practice. Therefore, Applicants note that a successful test for software with respect to showing actual reduction to practice does not need to be bugs free.

In the filed 1.131 declaration, the inventors declared in Exhibit A all the claimed limitations are supported by statements of fact and evidence and that Exhibits B-D are test scripts and Exhibit E are copies of the output generated by those test scripts and Exhibit F shows the

successful tests of the above scripts. Therefore, the 1.131 declaration satisfies the requirements to show that the claimed invention had been actually reduced to practice.

“In evaluating whether a particular test constituted an actual reduction to practice, one factor to be considered is whether or not the inventor considered the test to be successful at the time.” >See, e.g., *Walkup v. Greig*, 332 F.2d 800, 141 USPQ 777 (CCPA 1969).< As stated in the 1.131 declaration, the inventors considered the test to be successful.

The inventors have declared that Exhibit F shows successful test results. The declaration declared that Exhibit F shows the results of a successful test. The declaration declared that expected results were produced. As stated in the Declaration, the documents in Exhibit F are copies of files that display the result of running the tests and demonstrate that the test ran correctly with the expected results. As declared, Exhibit F shows that the testing for the claimed invention is successful and worked for its intended purpose because regression tests were performed to verify that the operations performed by the test scripts generate the specified output as stated in the Declaration. Thus, actual reduction to practice is clearly shown in the 1.131 declaration because an embodiment of the invention actually existed and worked for its intended purpose.

In response to the filing of the June 26, 2007 1.131 declaration, the Office Action includes a general allegation that states the 1.131 declaration is ineffective because (1) the evidence does not indicate that the apparatus worked as intended because the output of the test script included bugs such as ykunitom_bu-704908_1. The Office Action questioned the showing of successful test because the results in Exhibit F allegedly included bug(s).

The mere existence of bugs does not render the claimed invention inoperative and is not prima facie evidence that the claimed invention was not reduced to practice. On the contrary, the 1.131 declaration clearly proves that the alleged bugs were not critical because even with outputs such as ykunitom_bu-704908_1 successful test results were obtained according to the 1.131 declaration.

In order to meet the Examiner's burden of proof, the Examiner needs to provide a factual basis to show that the claimed invention was not successfully tested by a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 226 USPQ 1 (Fed. Cir. 1985). In the latest Office Action, the Examiner states that actual reduction to practice did not occur by just pointing to a line in the printout of Exhibit F. The Examiner failed to meet his burden of proof by merely

pointing to a line that is labeled as a bug in the printout of the Exhibit F, when the inventors indicated that the tested system worked for its intended purpose despite the test result. The Examiner did not explain the relevance, importance, or even what the bug is as to why that bug would lead to a conclusion of an unsuccessful test. As stated above, the successful result does not have to be bugs free as long as it worked for its intended purpose. The examiner failed to explain why the bug caused the test result to show that the claimed invention did not work for its intended purpose. The Examiner's reasoning is so uninformative that it prevents the Applicants from recognizing and seeking to counter the Examiner's position. >See, e.g., *Chester v. Miller*, 906 F.2d 1576, 15 USPQ2d 1333 (Fed. Cir. 1990).< Because the Examiner failed to show by a preponderance of evidence that the tested system failed to work for its intended purpose, the Examiner did not meet his burden of proof.

It is improper for the Examiner to find the test results of Exhibit F to be not successful by pointing to some lines of the printout without providing adequate reasoning or evidence. Therefore, the Examiner failed to meet his burden of proof to show that actual reduction to practice did not occur.

Regarding the mapping of (2), Applicants would like to thank the Examiner for the telephone conversation of July 14, 2008 for the opportunity to explain to the Examiner the support and statements of fact and how they corresponded to the claimed limitations. The Examiner agreed to withdraw the rejection regarding lack of mapping. Thus, paragraphs 4-44 are not general allegations and all the claimed limitations are supported by evidence as stated in the 1.131 declaration.

Therefore, the 1.131 declaration is effective, and it is respectfully submitted that Anderson cannot be used as prior art to anticipate or render obvious the claimed subject matter.

Claim Rejections - 35 USC § 103

Claims 1-14 and 16-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US Patent No. 6,442,600 B1) in view of Smith et al. (6,282,564 B1).

The declaration filed on March 20, 2006 under 37 CFR 1.131 has been deemed ineffective to overcome the Anderson (US 6,442,600) reference. All pending claims have been rejected under 35 USC 103(a) as being unpatentable over Anderson in view of Smith et al. (US 6,282,564). Applicants respectfully traverse.

The Anderson reference was filed on January 15, 1999 and was issued on August 27, 2002. Therefore, this reference is being cited as 102(e) art and is thus eligible to be overcome based upon an affidavit or declaration from an inventor pursuant to 37 CFR 1.131. See MPEP Section 715.

For at least the above reasons, it is respectfully submitted that Anderson cannot be used as prior art to anticipate or render obvious the claimed subject matter. Therefore, the Smith reference alone fails to disclose all the features of the claims and does not render the pending claims obvious.

Moreover, it is respectfully noted that Applicants do not acquiesce in the basis of the rejection, e.g., there is insufficient reasons to combine the Anderson and Smith references to arrive at the claimed subject matter, and that even if a combination is made, the resulting combination does not include all elements of the claimed invention.

CONCLUSION

Based on the foregoing, all claims are believed allowable, and an allowance of the claims is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

To the extent that any arguments and disclaimers were presented to distinguish prior art, or for other reasons substantially related to patentability, during the prosecution of any and all parent and related application(s)/patent(s), Applicant(s) hereby explicitly retracts and rescinds any and all such arguments and disclaimers, and respectfully requests that the Examiner re-visit the prior art that such arguments and disclaimers were made to avoid.

The Commissioner is authorized to charge Vista IP Law Group LLP Account No. 50-1105 for any fees required that are not covered, in whole or in part, and to credit any overpayments to said Deposit Account No. 50-1105.

Respectfully submitted,

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